

### **REMARKS**

Applicant thanks the Examiner for the remarks and analysis contained in the Office Action. Applicant is especially grateful for an indication of allowable subject matter. New claims 17-25 are added. Claims 1, 4-8, 10 and 11 are amended above. Applicant respectfully requests reconsideration of this application.

Applicant respectfully traverses the rejection under 35 U.S.C. §102 of claims 1-2 and 4-5 as being anticipated by *Jacobs*. Claim 1 recites an arrangement where a clearance volume increases to decrease a mass flow rate of a compressor as an ambient temperature increases. The *Jacobs* reference teaches an oppositely functioning arrangement. In the *Jacobs* reference, the modulating piston 94 moves to decrease the size of the compression chamber 70, which decreases the output of the *Jacobs* compressor responsive to low or decreasing ambient temperatures. As ambient temperatures increase, the output of the *Jacobs* compressor increases. This can be appreciated, for example, from *Jacobs*' teachings at column 2, lines 3-8; column 3, lines 48-55; and column 4, lines 6-22. As the arrangement of claim 1 operates in a completely different manner than that taught in *Jacobs*, there is no anticipation.

Applicant respectfully traverses the rejection under 35 U.S.C. §103 of claims 6-10 and 12-16 as being unpatentable over *Jacobs* in view of *Mei, et al.* There is no *prima facie* case of obviousness. When there is no benefit to making a proposed combination, there is no motivation for making that combination and no *prima facie* case of obviousness. In this instance, *Jacobs* teaches an air conditioning compressor for use on automotive vehicles. There would be no benefit to adding a water heater arrangement to the *Jacobs* arrangement because automotive vehicles do not require water heaters.

Therefore, the addition of the teachings of *Mei, et al.* to the *Jacobs* arrangement provides no benefit and serves no purpose. Therefore, there is no motivation for making the combination and the claims cannot be considered obvious.

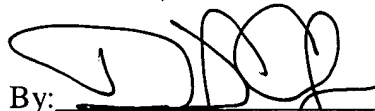
None of the new claims can be considered anticipated or obvious in view of the cited references. Claim 21 presents the subject matter of original claim 3 rewritten in independent form, which the Examiner has already indicated as being allowable. None of the references include a controller like that recited in claim 22. Claim 25 recites an arrangement that operates in an opposite manner compared to the teachings of the *Jacobs* reference.

Applicant respectfully submits that this case is in condition for allowance. If the Examiner believes that a telephone conference will facilitate moving this case forward to being issued, Applicant's representative will gladly discuss any issues regarding this application and can be contacted at the telephone number indicated below.

Applicant believes that additional fees in the amount of \$850.00 are required for three additional independent claims and five claims in excess of twenty. A check in the amount of \$850.00 is enclosed. The Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

CARLSON, GASKEY & OLDS

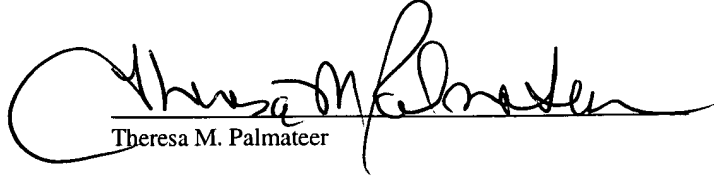
By: 

David J. Gaskey, Reg. No. 37,139  
400 W. Maple Rd., Ste. 350  
Birmingham, MI 48009  
(248) 988-8360

Dated: February 24, 2005

**CERTIFICATE OF MAILING**

I hereby certify that the enclosed Amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on February 24, 2005.

  
Theresa M. Palmateer

N:\Clients\CARRIER\IP00260\PATENT\Response 2-05.doc